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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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SERIAL NO. 10 520 571 — **Art Unit: 1714**

FILED: JANUARY 7 2005 — **Examiner:** SZEKELY, P. A

FOR: FLAME RETARDANT THERMOPLASTIC RESIN COMPOSITION — Docket No: DKC 1775

Commissioner for Patents
Alexandria, VA 22313

REPLY BRIEF

This is reply to the Examiner's Answer. The Answer in the above application is essentially the same as the Examiner's Answer in the related appeal in Serial No. 10 520 842. Therefore, the content of this Reply is essentially the same as the Reply in related appeal, Serial No. 10 520 842. As noted therein, the Examiner's Answer clearly sets forth the fundamental error in the rejections: the examiner failed to properly apply the standard set forth in 35 USC §112, paragraph 1 of "a person skilled in the art to which it pertains", in this case, polymer chemistry or polymer engineering. Instead, the examiner has erroneously applied a "ordinary skill in the art of patent examining" standard as shown by the arguments on page 4 of the Answer referring to "the *legal* meaning of the phrase 'consisting of' which counts, a patent application is a *legal* document" (emphasis added). The examiner admits that he is relying on the *legal*

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meaning of "consisting of". This is clear error since it is well established that the proper standard is what the specification conveys to one of ordinary skill in the pertinent *technical* art.

Under U.S. patent law, "a person skilled in the art" is a person of *ordinary* skill in the *technical* subject matter of a patent application. In the present appeals, the pertinent art is polymer chemistry or polymer engineering. The examiner has not presented any evidence that an average polymer chemist or engineer would have any legal training whatsoever much less be exposed to such advanced patent law topics as claim construction. Such topics are taught in law school, the Patent Academy in the USPTO or patent law classes directed to attorneys and patent agents.

As noted in the Appeal Brief, the inquiry into whether the description requirement is met is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The examiner has erroneously treated the issue as a legal question and applied legal reasoning. The correct analysis is determination of a factual question from the perspective of one of ordinary skill in polymer chemistry or engineering as mandated by 35 USC §112, paragraph 1.

The examiner has also erred in the application of U.S. patent law relating to claim construction to the issue of the interpretation of the content of the specification by one of ordinary skill in the technical art. The examiner did not present any legal precedent or reasoning to support the application of the principles of claim construction to interpretation of the specification. Applicants submit that he has not done so because his position is contrary to the statute. Therefore, there is no precedent or sound legal reasoning supporting his position. A patent is a legal document subject to the requirements of the patent statutes and case law which clearly require that the specification is to be interpreted from the perspective of one of ordinary skill in the art, i.e., technical art.

It is also noted that the examiner did not dispute the applicability of *In re Peters*, 723 F.2d 891, 221 USPQ 952 (Fed. Cir. 1983) (The removal of an unnecessary limitation does not violate the written description requirement) and did not adequately respond to Applicants' related arguments.

Applicants submit that the examiner erred in rejecting the claims as being unpatentable under 35 U.S.C. §112, first paragraph for failing to meet the written description requirement because the examiner has failed to support his position by either evidence or *technical* reasoning. The reason for the rejection provided by the examiner 1) is based on the wrong standard of "ordinary skill in patent examining" instead of the statutory standard of a person skilled in the pertinent technical art and 2) is an erroneous application U.S. patent law relating to claim construction to the issue of the interpretation of the technical content of the specification. Therefore, the examiner has failed to rebut the presumption that Applicants' description was adequate as filed.

For the reasons set forth in the Appeal Brief and this Reply Brief, Applicants respectfully request reversal of the Examiner's rejections under 35 U.S.C. §112.

Respectfully submitted,

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